APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,781	05/02/2001	Steven J. Hulai	92509-3	4596

22463 7590 12/18/2007		

SMART AND BIGGAR
438 UNIVERSITY AVENUE
SUITE 1500 BOX 111
TORONTO, ON M5G2K8
CANADA

EXAMINER
LE, DEBBIE M

ART UNIT	PAPER NUMBER
2168	

MAIL DATE	DELIVERY MODE
12/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	09/846,781	HULAI ET AL.
	Examiner	Art Unit
	DEBBIE M. LE	2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 October 2007*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant's arguments on October 12, 2007. Claims 1-16 remain for examination.

Specification

Applicant is reminded of the proper language and format for an abstract of the

disclosure.

The abstract is objected because it contains legal phraseology often used in

patent claims, such as "means" and "said," should be avoided (see Applicants' abstract,

for example, line 10, respectively).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are provisionally rejected on the ground of nonstatutory double patenting over claims 1, 2, 5, 6, 9, 10, 11, 12, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 28 of copending Application No. 10/537,428. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Claims 1, 2, 5, 6, 9, 10, 11, 12, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 28 of the patent application 10/537,428 contain elements of claims 1-16 of the instant application and as such anticipates claims of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re* Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in for prior art patents); *In re* Berg, 140 F.3d at 1437, 46 USPQ 2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). "ELILILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeal for the Federal Circuit, ON PETTITION FOR REHEARING EN BANC (DECIDED: May 30, 2001)".

Thus, this is a **provisional** obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Yach

(US Patent Application. Pub. No 2002/0112078 A1).

As per claim 1, Yach discloses a method of presenting data from an

application (para. 0002 web browser application) **executing at a computing device at·**

a remote wireless device comprising:

receiving at said wireless device, a representation of a text file (para. 0002,

displaying web content on a client device) **defining:**

a format of a user interface for the application at said wireless device (para.

0045, as visual output, a screen and output media components displays to the user the

existing state of the VM environment);

a format of network messages for exchange of data generated by said

application (para. 0012, 0038-0039, wherein the wireless handheld device receives the

defined virtual machine language, para. 0041, output the common run-time virtual

machine (hereinafter "VM") programs into an optional byte-code generator that accepts

the VM program as input and turns the source code representation into byte-code

representations),

a format for storing data related to said application at said wireless device

(Fig. 3, para. 0046, file storage);

receiving data from said application in accordance with said format of

network messages (para. 0047, receiving program directly from the file explorer and

interface storage), and presenting said data at said wireless device using said user

interface (para. 0038, 0045, 0048, displaying to the user the existing state of the virtual

machine programs).

As per claim 2, Yach teaches wherein said text file is received at said device

and wherein said text file is an XML file (para. 0039).

As per claim 3, Yach teaches wherein said text file is parsed, and a

representation of said text file is stored at said device (para. 0011).

As per claim 4, Yach teaches storing data generated by said

application at said wireless device using said format for storing data (para. 0011).

As per claim 5, Yach teaches the text file defines screens, events arising in

response to interaction with said screens, and actions for processing said events (para.

0012).

As per claim 6, Yach teaches wherein said format of network messages

comprises XML definitions for said network messages, and wherein data for said

application are dispatched from said mobile device using said XML definitions (para.

0008, 0038).

As per claim 7, Yach discloses a wireless mobile device comprising:

a processor, computer readable memory in communication with said

processor (Fig. 1, device side, para. 0009), storing virtual machine software

controlling operation (para. 0010, transmitting virtual machine language to a wireless

handheld device receives) of said device said virtual machine software comprising:

a parser (VM interpreter) for receiving a text file (para. 0002, displaying web

content on a client device);

a screen generation engine (byte code generator), for presenting at least one

screen at said device in accordance with said text file (para. 0012, 0009, a wireless

handheld device receives the defined virtual machine language, para. 0041, output the

common run-time virtual machine (hereinafter "VM") programs into an optional byte-

code generator that accepts the VM program as input and turns the source code

representation into byte-code representations, or para. 0007, the translated VM

program);

an event handler for processing events arising in response to interaction

with said at least one screen in accordance with said text file (para. 0045, file

explorer and storage interface component uses the screen and output media

component in response to user's making selections on the virtual output listing of

programs);

object classes corresponding to actions to be taken by said wireless

mobile device in response to interaction with said at least one screen (par. 0047,

0038, after the VM program has been retrieved by the explorer and storage interface

component, the VM engine launches with an indicator of which program to execute. The

VM engine then receives the program directly from the file explorer or retrieve the

program to be executed from the file system 550),

an object classes corresponding to a data table for storing data at said

wireless mobile device (Fig. 3, file storage);

an object class corresponding to a network message to be received or

transmitted by said wireless mobile device (para. 0038).

As per claim 8, Yach teaches wherein said memory further stores a

representation of said text file (Fig. 3, file storage).

As per claim 9, Yach teaches wherein said representation of said

text file is created by said parser (para. 0012).

As per claim 10, Yach teaches wherein said parser comprises an XML parser

(para. 0039).

As per claim 11, Yach teaches wherein said object classes

corresponding to action to be taken comprise object classes that present screen

elements at said device (para. 0036, 0038).

As per claim 12, Yach teaches object classes enabling exchange of data

between said wireless device and a computing device over a network, wherein said

data is formatted in accordance with definitions within said text file (Fig. 3, para. 0043).

Claim 13 is rejected by the same rationale as state in independent claim 1

arguments.

Claims 14-16 have similar limitations as claims 2-6; therefore, they are rejected

under the same subject matter.

Response to Arguments

Applicant's arguments on October 12, 2007 have been considered and found

persuasive; therefore, the rejection has been withdrawn. However, upon further

consideration, a new ground(s) of rejection is made in view of the above detailed

rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to DEBBIE M. LE whose telephone number is (571) 272-

4111. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DEBBIE LE
PRIMARY EXAMINER

12/13/07